

Response under 37 C.F.R. § 1.111  
Attorney Docket No. 031145  
Serial No. 10/658,744

### **REMARKS**

Claims 1 and 3-11 are pending in the present application and are rejected. Claims 1, 4-7, and 9-11 are herein amended.

#### **Applicant's Response to Claim Rejections under 35 U.S.C. § 112**

Claims 1 and 3-11<sup>1</sup> were rejected under 35 U.S.C. § 112, second paragraph, as being unpatentable for failing to particularly point out and claim the subject matter regarded as the invention.

The Office Action argues that the terms “small opening,” “opening,” “first opening,” and “second opening” used in claims 1 and 3-11 are indefinite because it is unclear what is being referred to when the word “opening” is used. In response to this rejection, Applicant has amended the claims to provide better clarity. Specifically, Applicant's amendments make the drug delivery opening 4a distinct from the air intake openings 2a and 2b. Favorable reconsideration is respectfully requested.

#### **Applicant's Response to Claim Rejections under 35 U.S.C. § 102**

Claims 1 and 3-11 were rejected under 35 U.S.C. § 102(a) as being anticipated by **Sladek (U.S. Patent No. 6,039,042)**. The Office Action argues that **Sladek** discloses a metered dose inhaler 40 with a removable whistle 15. The Office Action goes on to argue that this whistle makes a sound when the inhalation is properly done.

---

<sup>1</sup> The Examiner states in the Office Action that claims 1-11 are rejected under 35 U.S.C. § 112. This is presumed to be an error, since claim 2 has been cancelled. Thus, Applicants assume that claims 1 and 3-11 are rejected.

In response to this rejection, Applicant amends the claims to recite a whistle having a partition wall, an air vent, a hollow resonant chamber, and a protrusion. These structural features are disclosed at page 9, line 17 to page 10, line 20, and in Figures 5 and 6. The whistle 15 of **Sladek** does not disclose or suggest these features.

Furthermore, Applicant respectfully submits that the claimed invention is not an obvious modification of **Sladek** due to the difference in functional language between **Sladek** and the claimed invention. Independent claims 1 and 7 recite an asthma drug inhaler "...wherein the whistle makes a sound when the inhalation is properly done." The object of the present invention is to allow patients to learn how to correctly use the inhaler based on an audible alert. When a patient has learned how to properly operate the inhaler, he or she may remove the whistle. See page 5, line 5 to page 6, line 6 of the specification. The whistle only makes a sound when inhalation is done properly.

On the other hand, **Sladek** discloses a whistle which makes a sound when inhalation is improperly done due to inhalation being too strong. **Sladek** actually discloses the opposite of the claimed invention, an inhaler with a whistle which makes a sound when the inhalation is improperly done. "At the opposite end of main chamber 12, a removable whistle element 15 (Fig. 4) is installed to alert the patient if he/she is inhaling too strongly." Column 4, lines 10-13. Thus, the whistle of **Sladek** only makes a sound when inhalation is done improperly. This teaches away from an inhaler where the whistle makes a sound when inhalation is properly done,

Response under 37 C.F.R. § 1.111  
Attorney Docket No. 031145  
Serial No. 10/658,744

as in the claimed invention. If the whistle of **Sladek** also made a sound when inhalation is properly done, the whistle would make a sound under all conditions, both proper and improper inhalation. This would be useless to a patient, since an always-sounding whistle would therefore no longer serve as a useful alert of any kind.

In summary, Applicant respectfully submits that the invention according to the presently amended claims is patentably distinct over **Sladek** due to differences in the structure of the claimed invention. Further, Applicant submits that the invention according to the currently amended claims is not obvious in light of **Sladek** because **Sladek** does not teach or suggest a whistle which makes a sound when inhalation is done properly. Favorable reconsideration is respectfully requested.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art. Favorable reconsideration is earnestly solicited.

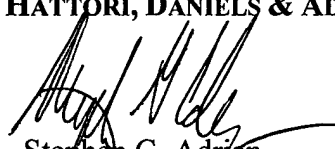
Should the Examiner deem that any further action would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone Applicant's undersigned attorney.

Response under 37 C.F.R. § 1.111  
Attorney Docket No. 031145  
Serial No. 10/658,744

If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read 'Stephen G. Adrian', is written over the printed name.

Stephen G. Adrian  
Attorney for Applicant  
Registration No. 32,878

**Atty. Docket No.: 031145**  
**Customer No.: 38834**  
1250 Connecticut Avenue NW Suite 700  
Washington, D.C. 20036  
Tel: (202) 822-1100  
Fax: (202) 822-1111  
SGA/RBC/ya